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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/830,180	04/22/2004	Satoru Wakao	1232-5393	7729
27123	7590	03/20/2008	EXAMINER	
MORGAN & FINNEGAN, L.L.P. 3 WORLD FINANCIAL CENTER NEW YORK, NY 10281-2101			PICH, PONNOREAY	
			ART UNIT	PAPER NUMBER
			2135	
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary	Application No. 10/830,180	Applicant(s) WAKAO ET AL.	
	Examiner PONNOREAY PICH	Art Unit 2135	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 16 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 22 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>4/04</u> . | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claims 1-18 are pending.

Priority

Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

Documents listed in the IDS submitted on 4/22/04 have been considered.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-8 and 17 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

Claim 1 is directed towards an imaging processing apparatus comprising an alteration means and control means. The recitation of alteration means and control means invokes 112, 6th paragraph. Applicant's specification discloses at least one embodiment of the claimed invention which is implemented as software code alone (see paragraph spanning pages 44-45 of the specification). As such, it would appear that the alteration means and control means recited in claim 1 can be interpreted to refer to software per se since claim 1 invokes 112, 6th paragraph. Software by itself is not a process, machine, manufacture, or composition of matter and absent accompanying hardware, cannot realize any functionality, thus cannot produce any concrete, useful, or tangible result. As such, claim 1 is rejected as being directed towards non-statutory

subject matter. Claims 2-8 are dependent on claim 1 and also appear to be directed towards software per se, thus are also non-statutory for similar reasons as claim 1.

Applicant may overcome these rejections by reciting at least one hardware as part of the claimed apparatus of claim 1.

Claim 17 is directed towards a computer program, i.e. software per se, thus is also rejected as being directed towards non-statutory subject matter.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-18 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kondoh et al (US 6,968,058) in view of de Queiroz (US 2004/0013268) in further view of Yamasaki et al (US 7,154,535).

Claims 1, 9, 17, and 18:

As per claim 1 Kondoh discloses an alteration means for altering the content of a first image file and read from a recording medium, in accordance with a user's instruction, and generating a second image file (col 5, lines 53-67 and col 6, lines 15-32). The cited sections disclose that the user can select various modes of the camera. Depending on which mode is selected, a first image file is read from a specific recording medium and processed/alterd in various manners. As such, the first image file is read from a medium in accordance with a user's instructions as conveyed by the user's

choice of camera mode. For example, if a digital watermark mode is selected, the medium to be read from is image memory 6 and the read first image file is digitally watermarked to create a second image, which is stored and managed by filing management unit 13. If an alteration monitory mode is selected, the first image file is read from either storage medium 17 or an external unit. This acquired first image file then has a MAC added to the header and the resulting second image is stored the filing management unit 13.

Kondoh does not explicitly disclose a control means for, if authentication data is added to said first image file, record said second image file onto said recording medium without deleting said first image file.

However, de Queiroz discloses a control means which only transfers an image to a second location if authentication data has been added to a first image file (paragraphs 36 and 40). In de Queiroz's invention, authentication data is embedded into the entire image. Only once the entire embedding procedure is finished does the image get transferred and recorded at the second location—this implies a control means which only records a second image file if authentication data is added to the first image file. Recall that in the alteration monitor mode, Kondoh's invention also embeds authentication data onto an image, but using a different embedding method (col 6, lines 23-26).

In light of de Queiroz's teachings, at the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to modify Kondoh's camera to embed authentication data in a first image using de Queiroz's teachings and to include

a control means which records said second image file onto said recording medium if authentication data is added to said first image file. Modifying Kondoh's camera in the manner discussed is obvious because it is the simple substitution of one known element for another to obtain predictable results and having the discussed control means would ensure that the image has been embedded with the needed authentication data before recording to the recording medium.

de Queiroz also does not explicitly disclose recording of the second image file without deleting the first image file. However, Yamasaki discloses recording a second image file without deleting a first image file (col 5, lines 19-47). The thumbnail discloses by Yamasaki is a smaller copy of the first image file which is recorded onto a medium without deleting the first image file. At the time applicant's invention was made, it would have been obvious to one of ordinary skill in the art to further modify Kondoh's invention such that the recording of the second image is done without deleting the first image file. One skilled would have been motivated to not delete the first image file when recording the second because keeping the first image file would provide a backup in case the second image file becomes corrupted or lost.

Claim 9 is directed towards a method performed using the apparatus of claim 1 and is rejected for much the same reasons as claim 1. Claim 17 is directed towards a computer program for realizing the respective steps of claim 1. Claim 17 is rejected for much the same reasons as claim 1 because applicant invokes 112, 6th paragraph for claim 1 and the specification discloses that the claimed apparatus of claim 1 is implemented as a computer program (paragraph spanning pages 44-45 of the

specification). Claim 18 is directed towards a computer-readable recording medium holding the computer program according to claim 17 and also rejected for much the same reasons as claim 1.

Claims 2 and 10:

Yamasaki further discloses wherein said second image file is recorded in the same folder as a folder in which said first image file is recorded (col 5, lines 19-47 and Fig 9, item 92).

Claims 3 and 11:

Kondoh further discloses wherein said second image file is recorded in a folder different from a folder in which said first image file is recorded (col 6, lines 27-32). The first image is located in a storage medium 17 or an external unit while the second image file is stored in filing management section 13. Since the two image files are located in different mediums, they are also recorded in different folders.

Claims 4 and 12:

Kondoh further discloses wherein said second image file is recorded on a recording medium different from the recording medium on which said first image file is recorded (col 6, lines 27-32; Fig 1; and Fig 3). The first image is located in a storage medium 17 or an external unit while the second image file is stored in filing management section 13. Filing management section 13 is a different medium than storage medium 17 and being internal to the camera, is not an external unit.

Claims 5 and 13:

As per the limitation of wherein if a content of said first image file is altered, said authentication data is deleted from said second image is obvious to the combination invention of Kondoh, de Queiroz, and Yamasaki. In both Kondoh and de Queiroz's invention authentication data is added to the first image file to create the second image file to attest to the fact that the first image file has not been altered (Kondoh: col 5, lines 37-45 and de Queiroz: paragraph 36). A person of ordinary skill in the art having common sense and ordinary creativity would realize that if the first image file has been altered, it would not be honest to add authentication data to the first image file to create the second image file. As such, if the second image file were to be created from an altered first image file, it would have been obvious to one of ordinary skill in the art to delete authentication data from the second image file. One skilled would have been motivated to do so to keep from falsely testifying that an image has not been altered.

Claims 6 and 14:

Kondoh further discloses wherein information on said first image file (i.e. MAC) is added to said second image file (col 6, lines 23-44).

Claims 7 and 15:

Yamasaki further discloses wherein a part of a file name of said second image file is the same as part of a file name of said first image file (Fig 9, item 92). For example, a second image file having the name "image1, thumbnail image" is related to a first image file having the name "image1". Both the first and second image files have "image1" as part of their file names.

Claims 8 and 16:

Kondoh further discloses wherein said image processing apparatus is an image sensing apparatus (Fig 1, digital camera 100).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to PONNOREAY PICH whose telephone number is (571)272-7962. The examiner can normally be reached on 9:00am-4:30pm Mon-Thurs.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Kim Vu can be reached on 571-272-3859. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Ponnoreay Pich/
Examiner, Art Unit 2135